

AUS920010833US1

REMARKS

Claims 1-54 are in the case. Applicants have amended claim 54 to repair a minor typographical error in the claim. Claims 1-49 stand rejected under 35 U.S.C § 103(a) as unpatentable over Borland (U.S. Patent No. 6,178,230). Claims 50-54 stand rejected under 35 U.S.C § 103(a) as unpatentable over Borland (U.S. Patent 6,178,230) in view of Farris *et al.* (U.S. Patent No. 6,122,357). Applicants respectfully traverse each rejection below.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify Borland or to combine Borland and Farris. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification of Borland or the proposed combination of Borland and Farris. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification of Borland or the proposed combination of Borland and Farris must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, neither the modification of Borland, nor the combination of Borland and Ferris establishes a prima facie case of obviousness. The rejection of claims 1-54 should therefore be withdrawn and the case should be allowed.

BORLAND**No Suggestion To Modify Borland**

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Borland. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir.

AUS920010833US1

1991). The suggestion or motivation to modify Borland must come from the teaching of Borland itself and the Examiner must explicitly point to the teaching within Borland suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The present application is entitled "Identifying a Call Made or Received On Behalf of Another" and each and every claim in the case claims an "on behalf of action." The Office Action admits that Borland does not disclose an on behalf of action. Office Action dated March 15, 2004, page 2, rejection 2. Despite the admission that Borland does not disclose on behalf of actions, the Office Action states that because Applicants' claims are broad, the Examiner interprets Borland as disclosing on behalf of action. Office Action dated March 15, 2004, page 2, rejection 2. The suggestion to modify Borland must come from the teaching within Borland, not the breadth of Applicants' claims. In fact, the breadth of Applicants' claims is irrelevant to what is or is not disclosed in Borland. Applicants' claims are broad and patentable. Regardless of the breadth of Applicants' claims, to establish a prima facie case of obviousness, the Examiner must point to teaching within Borland suggesting an on behalf of action. Absent such a showing, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. The Examiner has not pointed to any disclosure in Borland suggesting an on behalf of action. As such, the proposed modification of Borland cannot establish a prima facie case of obviousness.

Turning now to the substance of Borland, Borland actually teaches away from on behalf of actions. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Borland discloses an individualized distinctive telephone ring to identify a particular callee. Borland, Col 3, lines 60-65. The

AUS920010833US1

telephone ring is individualized and distinctive for a particular callee and therefore is an action on behalf of the callee—not an action on behalf of another. As such, Borland teaches away from actions on behalf of others by teaching telephone rings individualized for a particular callee. Because Borland teaches away from an on behalf of action, the proposed modification cannot support a prima facie case of obviousness. The rejection of Applicants' claims should be withdrawn and the case should be allowed.

No Reasonable Expectation Of
Success in the Proposed Modification of Borland

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Borland. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Borland. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, Borland teaches an individualized distinctive telephone ring for a particular callee. Borland, Col 3, lines 60-65. To modify Borland to create a distinctive telephone ring on behalf of another rather than the callee would fundamentally change the principle of operation of Borland because the individualized and distinctive telephone ring would no longer identify the callee. Identifying another rather than the callee frustrates the principle of operation of Borland. The proposed modification of Borland therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

BORLAND AND FARRIS

Claims 50-54 stand rejected under 35 U.S.C § 103(a) as unpatentable over Borland (U.S. Patent No. 6,178,230) in view of Farris *et al.* (U.S. Patent No. 6,122,357). The proposed combination cannot establish a prima facie case of obviousness.

AUS920010833US1

No Suggestion Or Motivation To Combine
Borland And Farris

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Borland and Farris. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The present application is entitled "Identifying a Call Made or Received On Behalf of Another" and independent claim 50 includes "an on behalf of action." There is no suggestion or motivation to modify Borland to include an on behalf of action and then combine Borland and Farris because Borland teaches away from on behalf of actions. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). As discussed above, Borland teaches an individualized distinctive telephone ring for a particular callee. Borland, column 3, lines 60-65. The telephone ring is individualized and distinctive to identify a particular callee. Such an individualized and distinctive telephone ring for a particular callee teaches away from an action invoked on behalf of another. As such, Borland teaches away from the proposed combination of Borland and Farris. The rejection of Applicants' claims should be withdrawn and the case should be allowed.

No Reasonable Expectation Of Success In The
Proposed Combination Of Borland And Farris

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Borland to include an on behalf of action and combination of Borland and Farris. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in the modification of Borland and the combination of Borland and Farris if the proposed modification changes the principle of operation of either Borland or Farris. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, Borland teaches an individualized distinctive telephone ring for a particular callee. Borland, Col 3, lines 60-65. To modify Borland to create a distinctive telephone ring on behalf of another rather

AUS920010833US1

than the particular callee would fundamentally change the principle of operation of Borland because the individualized and distinctive telephone ring would no longer identify the callee. Identifying another rather than the callee frustrates the principle of operation of Borland. The proposed modification of Borland and combination of Borland and Farris therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

The Combination Of Borland And Farris
Do Not Teach All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Borland and Farris must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 50 claims a "method for controlling a telephony device" including "automatically updating a context for a call to indicate an on behalf of action invoked by said party." The Office Action admits that Borland does not disclose "automatically updating a context for a call to indicate an on behalf of action invoked by said party." Office Action dated March 15, 2004, page 6, rejection 3. The Office Action also admits that Farris does not teach "automatically updating a context for a call to indicate an on behalf of action invoked by said party." Office Action dated March 15, 2004, page 6, rejection 3. Because neither Borland nor Farris disclose "automatically updating a context for a call to indicate an on behalf of action invoked by said party," the proposed combination of Borland and Farris cannot establish a prima facie case of obviousness. The rejection of claims 50-54 should therefore be withdrawn and the case should be allowed.

Conclusion

Claims 1-49 stand rejected under 35 U.S.C § 103(a) as unpatentable over Borland (U.S. Patent No. 6,178,230). Claims 50-54 stand rejected under 35 U.S.C § 103(a) as unpatentable over Borland (U.S. Patent 6,178,230) in view of Farris *et al.* (U.S. Patent No. 6,122,357). Both the proposed modification of Borland and the proposed

AUS920010833US1

modification of Borland and Farris fail to establish a prima face case of obviousness. The rejection of claim 1-54 should therefore be withdrawn and the claims should be allowed. Reconsideration of claims 1-54 in light of the present remarks is respectfully requested.

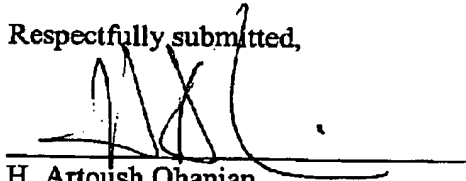
The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date:

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By:

Respectfully submitted,


H. Artoush Ohanian

Reg. No. 46,022

Biggers & Ohanian, LLP

504 Lavaca Street, Suite 970

Austin, Texas 78701

Tel. (512) 472-9881

Fax (512) 472-9887

ATTORNEY FOR APPLICANTS